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Patent Department

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## Facsimile Cover Sheet

TODAY'S DATE: April 17, 2006**PLEASE DELIVER THE FOLLOWING MESSAGE TO:**Examiners Name: L.E. CraneExaminer's fax number: 571-273-8300Examiner's phone number: 571-272-0651Group number: 1623**THIS MESSAGE IS FROM:**Name: Philippe L. DurettePhone No.: (732) 594-4568Mail Location: RY60-30Fax No.: (732) 594-4720RE: Applicants: B. Bhat, et alCase No.: 20717YCASerial No.: 10/688,691Filed: October 17, 2003Title: NUCLEOSIDE DERIVATIVES AS INHIBITORS OF RNA-  
DEPENDENT RNA VIRAL POLYMERASENUMBER OF PAGES BEING TRANSMITTED (INCLUDING COVER): 7

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PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: B. Bhat, et al.  
Serial No.: 10/688,691 (Case No. 20717YCA)

Art Unit:  
1623

Filed: October 17, 2003

Examiner:  
L.E. Crane

For: NUCLEOSIDE DERIVATIVES AS  
INHIBITORS OF RNA-DEPENDENT RNA  
VIRAL POLYMERASE

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TERMINAL DISCLAIMER UNDER 37 C.F.R. §1.321(b) (c)**

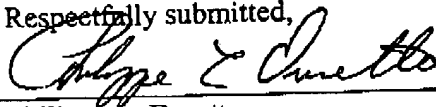
*Claims 22-27 and 30-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 13 of US Patent No. 6,777,395.*

Claims 22, 25, 27, 30, and 31 were cancelled in an Amendment filed February 17, 2006. The Applicants submit a Terminal Disclaimer under 37 CFR 1.321(b) to obviate the obviousness-type patenting rejection of remaining claims 23, 24, 26, and 32 subsequent to the Amendment filed February 17, 2006. The Applicants therein have disclaimed the terminal part of any patent issuing from the present application which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,777,395. The terminal disclaimer fully complies with 37 CFR 3.73(b). Accordingly, the double patenting rejection should be withdrawn.

Serial No.: 10/688,691  
Case No.: 20717YCA  
Page No.: 2

In view of the foregoing, it is respectfully requested that the Examiner allow the application to pass to issue.

The Applicants believe that all of the objections and rejections have been overcome by amendment and/or argument, and therefore earnestly solicit an early Notice of Allowance.

Respectfully submitted,  
By   
Philippe L. Durette  
Reg. No. 35,125  
Attorney for Applicants

MERCK & CO., Inc.  
P.O. Box 2000  
Rahway, New Jersey 07065-0907  
Tel. No. (732) 594-4568

Date: April 17, 2006

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: B. Bhat, et al.

U.S. Serial No.: 10/688,691

Filed: October 17, 2003

For: Nucleoside Derivatives As Inhibitors of RNA-Dependent RNA  
Viral Polymerase

Group No.: 1623

Examiner: L. E. Crane

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450TERMINAL DISCLAIMER TO OBVIATE  
A DOUBLE PATENTING REJECTION  
[37 CFR 1.321]

I, Melvin Winokur, residing at  
126 East Lincoln Avenue, Rahway, New Jersey 07065-0907, am a representative  
of the assignee identified below, empowered to act on its behalf, pursuant to attached  
Corporate Resolution No. 5, dated 05/24/2005.

The assignee, Merck & Co., Inc., certifies  
that it is the assignee of the entire right, title and interest in the above-identified  
patent application by virtue of an Assignment from the inventor(s) in the aforesaid  
patent application, which was

- ☒ recorded in the United States Patent & Trademark Office on Reel(s) 014753  
Frame(s) 0161 on 12/04/2003,  
☐ was forwarded for recording on \_\_\_\_\_, with a copy of the recordation form  
and assignment attached hereto, or  
☐ is being concurrently forwarded for recording under separate cover, with a copy of the  
recordation form and assignment attached hereto.

The aforesaid assignment establishes the ownership in the assignee of the above-identified  
application pursuant to 37 CFR 3.73(b).

The undersigned has reviewed all of the evidentiary documents in the chain of title of the  
above-identified patent application, and the undersigned certifies that, to the best of the  
undersigned's knowledge and belief, title is in the assignee named above.

I hereby disclaim the terminal part of the statutory term of any patent granted on the  
above-identified application, which would extend beyond the expiration date of the full  
statutory term of:

- ☒ United States Patent No. 6,777,395, or as presently shortened by any terminal  
disclaimer,  
☐ Any patent granted on application serial number \_\_\_\_\_,

and hereby agree that any patent so granted on the above-identified application shall be enforceable on, for and during such periods that the legal title to said patent shall be the same as the legal title to:

☒ United States Patent No. 6,677,395 ,

☐ Any patent granted on application serial number \_\_\_\_\_ ,

this agreement to run with any patent granted on the above-identified application and to be binding upon the grantor, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term of:

☒ United States Patent No. 6,677,395 , or as presently shortened by any terminal disclaimer,

☐ Any patent granted on application serial number \_\_\_\_\_ ,

in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

The Commissioner is requested to charge Account No. 13-2755 the sum of \$130.00 and any fee deficiency required by this paper. A duplicate of this disclaimer is attached.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.



Disclaimant Melvin Winokur

Attorney \_\_\_\_\_

Title \_\_\_\_\_

Merck & Co., Inc.

Patent Dept., RY60-30

P.O. Box 2000

Rahway, New Jersey 07065-0907

Telephone No. (732) 594-7234

In Duplicate  
Attachs.

Date: 04/06/2006

APR 17 2006

PTO/SB/26(10-00)

Approved for use through 10/31/2002. OMB 0651-0031

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**TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**Docket Number (Optional)  
**20717YCA**In re Application of: **Bhat, et al.**Application No.: **10/688,691**Filed: **October 17, 2003**For: **Nucleoside derivatives as inhibitors of RNA-dependent RNA viral polymerase**

The owner\*, Isis Pharmaceuticals, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of Prior Patent Nos. 6,777,395

The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patents are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☒ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record.

04/18/2006 TL0111 00000051 132755 10608691

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130.00 DA

Signature

Date

Grantland E. Bryce, Esq.

Typed or printed name

☐ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

☐ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to deposit account no. \_\_\_\_

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date shown below.

Dated: \_\_\_\_\_

Signature: \_\_\_\_\_ (Name)

PTO/SB/96 (09-04)  
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### STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Isis Pharmaceuticals, Inc.

Application No./Patent No.: 10/688,691 Filed/Issue Date: 10-17-2003

Entitled: Nucleoside derivatives as inhibitors of RNA-dependent RNA viral polymerase

Isis Pharmaceuticals, Inc., a Corporation  
 (Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or  
 2. ☐ an assignee of less than the entire right, title and interest.  
 The extent (by percentage) of its ownership interest is \_\_\_\_\_ %

in the patent application/patent identified above by virtue of either:

- A ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 014753, Frame 0192, or for which a copy thereof is attached.

OR

- B ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below.

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.  
 2. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.  
 3. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

[Signature]  
 Signature

4/5/06  
 Date

Grantland E. Bryce, Esq.  
 Printed or Typed Name

760.931-9200  
 Telephone Number

Vice President and General Counsel  
 Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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